

REMARKS

The Office Action of April 24, 2007 has been received and carefully considered. Applicant respectfully submits that the invention as claimed is not anticipated by or rendered obvious by the cited reference and traverses the rejection. All claims are now present for examination and favorable reconsideration is respectfully requested in view of the pending claim and the following comments.

REJECTIONS UNDER 35 U.S.C. § 102 /103:

Claim 1 has been rejected under 35 U.S.C. §102(e) as allegedly anticipated by or, in the alternative, under 35 U.S.C. §103 as allegedly being obvious over Bernacki (US 2004/0038109).

Applicant traverses the rejection and respectfully submits that the embodiments of present-claimed invention are not anticipated by nor obvious over Bernacki. According to MPEP 2131, "A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is respectfully submitted that Bernacki does not disclose or suggest that "a gasket arranged in a gasket groove, which is provided in one or both of said separator plates, and glued to each of both said separator plates" and other features as defined in Claim 1.

The purpose of the present invention is that, a gasket, which is formed on one of separators by simple dispenser method or screen printing method, is adhered to surfaces of both the separators via adhesives. In addition, a fuel cell is assembled in a manner that gasket is compressed and deformed, whereby leakage due to failure of sealing can be prevented when the gasket are adhered, even though the gasket made by the above method is held between both the separators with so small deformable compression as to generate low reaction force.

According to MPEP 2143.01, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). According to Bernacki, the gasket may be bonded to the plate by adhesive (see paragraph [0018] of Bernacki). However, there is no disclosure or suggestion that the gasket is formed by dispenser method or screen printing method.

According to MPEP 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). A product-by-process claim that defines different structures as result of the process of making the product should be considered for all of its limitations. Furthermore, bonding of the gasket in Bernacki means binding to only one of the separators. Figs. 2 and 3 do not suggest that the top ends of lips of the gasket are also bonded to an upper separator. Therefore, in Bernacki's structure, leakage due to failure of sealing may be caused at the side where the gasket is not bonded, when the gasket is deteriorated.

In addition, Bernacki discloses in, paragraph [0018] that "for the purpose of retaining the gasket in place, the gasket may be bonded to the plate instead by, for example, adhesive as known in the art" (emphasis added). However, the Examiner has incorrectly interpreted such description as "plates" (plural) to mean both separators. Therefore, Applicant respectfully submits Bernacki has not disclose nor suggest that the gasket is bonded to both separators as required by the pending Claim 1, for example, "a gasket arranged in a gasket groove, which is provided in one or both of said separator plates, and glued to each of both said separator plates."

Therefore, the newly presented claims are not anticipated by nor obvious over Bernacki, and the rejection under 35 U.S.C. §§102, 103 has been overcome.

Accordingly, withdrawal of the rejections under 35 U.S.C. §§102, 103 is respectfully requested.

Having overcome all outstanding grounds of rejection, the application is now in condition for allowance, and prompt action toward that end is respectfully solicited.

Respectfully submitted,

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